

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-6, 8, and 10-17 are in the application. Claims 7 and 9 previously were canceled.

In the second item on page 2 of the above-identified Office Action, claims 1-6, 8, and 10-17 have been rejected as being unpatentable over Kubinec (U.S. 6,192,069) in view of Ikuta et al. (U.S. 5,789,797) (hereinafter "Ikuta") under 35 U.S.C. § 103(a).

As will be explained below, it is believed that the claims were patentable over the cited art in their current form and, therefore, the claims have not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, an integrated circuit, having:

a radio-frequency (RF) filter device having first and second capacitors connected to the lines and being completely integrated in the integrated circuit for preventing and

restricting a propagation of high-frequency interference signals through the lines. (emphasis added)

According to the present invention there is provided an integrated circuit, which has integrated in it an RF filter device that can prevent or restrict the propagation of high-frequency interference signals through lines carrying DC voltages or low-frequency voltages. As a consequence, interference with the operation of the integrated circuit and/or of other integrated circuits, or of other components of the system containing the integrated circuit, can be prevented in a very simple yet extremely effective manner.

The RF filter device with first and second capacitors integrated in the integrated circuit at least partially obviates the need to provide external filters and/or to use particular circuit layouts.

Kubinec discloses a circuit for transferring signals between semiconductor devices having a serial connection over power supply line Vcc between IC200 and IC210. IC200 is a low pass filter 202 and a high pass filter 204, each being coupled to the supply line Vcc. The filter 202 is coupled to functional elements 208. The low pass filters 202 and 212 extract the low frequency component to provide a steady power supply

voltage to the components of IC200 and IC210. The low pass filter has a resistor 302 and a capacitor 304 connected in series between Vcc and ground.

Kubinec does not show "a radio-frequency (RF) filter device having first and second capacitors...for preventing and restricting a propagation of high-frequency interference signals" (emphasis added) as recited in claim 1 of the instant application.

The Examiner has acknowledged that Kubinec is deficient in that it does not disclose that a filter having a first and a second capacitor and moreover, a filter having a first and a second capacitor that prevents and restricts propagation of high-frequency interference signals through the lines as recited in the claims of the instant application. The Examiner erroneously attempts to overcome this deficiency by alleging that it would have been obvious to "...employ the...second capacitor..." of Ikuta in Kubinec to form "a second order low pass filter so that high frequency unwanted signals above the cut-off point of the filter would be highly attenuated." Applicants respectfully submit that such a conclusion is based purely on a hindsight reconstruction of the prior art after having read applicants' disclosure and is mere conjecture on the part of the Examiner without support in

the prior art. The Examiner's basis and reasoning for rejecting the claims under 35 USC 103 is faulted and improper, and is nothing more than arbitrary wishful thinking by the Examiner upon recognizing that the primary Kubinec reference is deficient in an important claimed feature of the instant invention.

The secondary Ikuta reference discloses a semiconductor device for suppressing electromagnetic noise. Toward this end Ikuta, inter alia, shows a an output low pass filter 15 to filtrate electromagnetic noise. A CR filter 39 and a CR filter 40 are connected in series between the output 12 and the circuit 10. The primary filter has a resistor R1 and a capacitor C1 and the secondary filter has a resistor R2 and a capacitor C2.

There is no reason, technical or otherwise, disclosed in Kubinec as to why one skilled in the art would want to or have need for providing the filter with a second capacitor. The filters in the secondary reference of Ikuta get rid of unwanted electromagnetic noise while Kubinec uses low pass filters to extract low frequency component to provide a steady power supply voltage. Applicants do not see any logical connection between these two references, much less any basis or technical reason disclosed therein for combining the references as proposed by the Examiner.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the Kubinec reference.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

In view of the foregoing, reconsideration and allowance of claims 1-6, 8, 10-17 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a

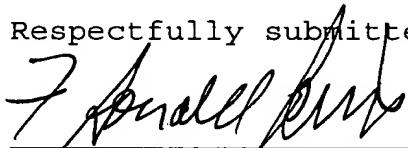
Appl. No. 09/839,767
Amdt. dated 3/3/05
Reply to Office action of 1/19/05

telephone call so that, if possible, patentable language can be worked out.

If an extension of time is required, petition for extension is herewith made.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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March 3, 2005

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